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## FACSIMILE COVER LETTER

FROM:

Robert Hardy Falk

DATED: 3-9-2000

SENDER'S PHONE NO.: (214) 954-4400

NUMBER OF PAGES (INCLUDING COVER): 8

TIME IN: 10:00 a.m.

PLEASE DELIVER THE FOLLOWING PAGES TO:

NAME:

Manuel Antonakas, Esq.

FIRM/COMPANY:

PTO, Director of Petitions

OUR CLIENT/MATTER NO.: WILL 2501

OFFICE TELEPHONE NO.:

FAX TELEPHONE NO.: (703) 308 6916

## SPECIAL INSTRUCTIONS

Enclosed is MPED 1442.02 and Court Orders. We were surprised  
to receive Office Action last Friday.

*P.S. 2d Order attached. Call (214) 6953402  
upon receipt.*

## CONFIDENTIALITY NOTICE

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If you do not receive all pages, please call (214) 954-4403 ASAP.

Thank you.

cc: Hiten

call 214-695-3402

214-979-3065  
ask for Mr. Falk.

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HILTON

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from 1:55

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March 9, 2000

Manuel Antonakas, Esq.  
Director, Petitions  
United States Patent & Trademark Office  
Crystal Plaza IV,  
Room 3D17  
Arlington, VA 22202

Re: Davis et al., Serial No. 09/315,796  
for "COMBINED LITHOGRAPHIC/FLEXOGRAPHIC  
PRINTING APPARATUS AND PROCESS"  
Our File: WILL 2501

Dear Mr. Antonakas:

Following up our conversation late yesterday afternoon, we were surprised to receive an office action on the captioned case in reissue and concurrent litigation. In July, 1999, the Northern District of Texas issued a stay, but reversed its position sometime later in the early fall. A copy of the original order is attached. I will obtain the second order reversing the first Order this morning. Apparently the Court did not forward a copy of the second Order to the P.T.O. I do not know if Protestor did.

M.P.E.P. 1442.02 applies, copy attached, in view of the concurrent litigation, and prosecution on the merits should not have commenced unless one of the four conditions occurred. The case is not terminated, and unfortunately, settlement has not occurred. The stay is lifted. Only reissue applicant can desire prosecution continue. That did not occur -- until now -- with this letter. However, the office action should not have been mailed until you received applicants' blessing to go ahead with the prosecution. Today, you have it. Accordingly, please reissue the office action consistent with our wishes today and M.P.E.P. 1442.02(D).

Very truly yours,



Robert Hardy Falk

Enclosures.

p.s.: Just received second order (10:20 a.m.) am attaching same.

09/315,796  
WILL 2501



Robert Hardy Falk

[illegible]



ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

PRINTING RESEARCH, INC, et al.,

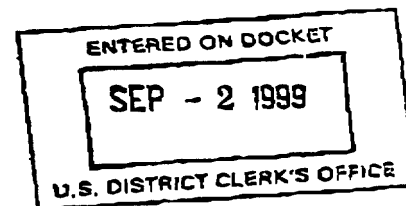
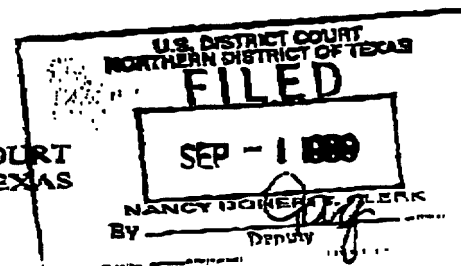
Plaintiffs,

VS.

WILLIAMSON PRINTING  
CORPORATION, et al.,

Defendants.

Civil Action No. 3:99-CV-1154-D



**ORDER**

On July 6, 1999 the court filed an order staying this case until completion of all proceedings in the United States Patent and Trademark Office ("PTO") relating to the application for reissue filed with the PTO on May 20, 1999 by defendant Williamson Printing Corporation. The court also directed that the clerk of court close the case for statistical purposes. Plaintiffs move the court *inter alia* to reconsider its stay order.

The court granted defendants' motion to stay based on its conclusion, from reviewing the briefing, that it would benefit the court by potentially obviating or narrowing this case, and benefit the parties by reducing the scope and expense of the litigation, if the court first permitted the PTO to act on the application for reissue. The court did not intend by its order to place one side at a disadvantage or substantively to affect a party's claims before this court. After further review on the fuller briefing that has been presented, including study of cases not previously cited and more specific analyses of the potential impact that the PTO proceedings could have on the parties to this lawsuit, the court concludes that the stay should be lifted and the case reopened statistically.

Accordingly, the court directs the clerk of court to reopen the case statistically, lifts the stay



imposed on July 6, 1999, and directs the parties to comply no later than September 30, 1999 with the court's June 14, 1999 order requiring submission of a joint scheduling proposal.

Plaintiffs' July 16, 1999 motion for reconsideration is granted. Their motion for certification of interlocutory appeal is denied as moot.

**SO ORDERED.**

September 6, 1999.

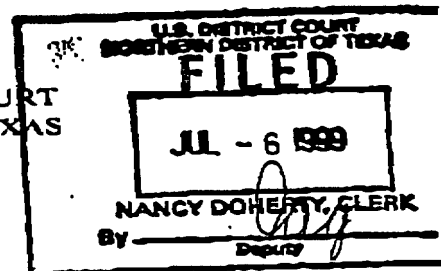
  
SIDNEY A. FITZWATER  
UNITED STATES DISTRICT JUDGE

03/15/99 05:20 PM  
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ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



PRINTING RESEARCH, INC.  
AND HOWARD W. DEMOORE,

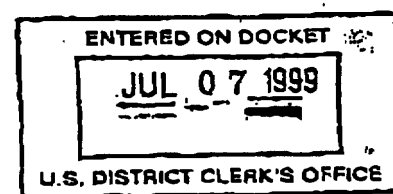
Plaintiffs,

v.

WILLIAMSON PRINTING  
CORPORATION, BILL L. DAVIS and  
JESSE S. WILLIAMSON,

Defendants.

CIVIL ACTION NO. 3-99CV1154-D



ORDER

Having considered Defendants' motion to stay, and the briefs of the parties in support of and in opposition to the motion, the Court finds that the motion should be granted and it is, therefore,

ORDERED that all proceedings in this action are stayed until the completion of the proceedings in the United States Patent and Trademark Office relating to the Application for Reissue of U. S. Patent No. 5,630,363 Under 35 U.S.C. § 251 and 37 C.F.R. § 1.171 filed by Williamson

Printing Corporation on May 20, 1999. The clerk shall close this case statutorily until the court directs that it be reopened.

Signed on this 6th day of June, 1999.

July

*Erin A. [Signature]*  
UNITED STATES DISTRICT JUDGE

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## 1442 Special Status

All reissue applications are taken up "special," and remain "special" even though applicant does not respond promptly.

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in "litigation" will be taken up for action in advance of other reissue applications.

### 1442.01 Litigation Related Reissues

During initial review, the examiner should determine whether the patent for which the reissue has been filed is involved in litigation, and if so, the status of that litigation. If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, will inquire regarding the specific details of the litigation.

Form paragraph 14.06 may be used for such an inquiry.

#### ¶ 14.06 Litigation Related Reissue

The patent sought to be reissued by this application (1) involved in litigation. Any documents and/or materials which would be material to patentability of this reissue application are required to be made of record in response to this action.

Due to the related litigation status of this application, **EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.**

#### Examiner Note:

In bracket 1, insert either **is** or **has been**.

If the additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

Where there is litigation, and it has not already been done, the examiner should place a prominent notation on the application file to indicate the litigation (1) at the bottom of the face of the file in the box just to the right of the box for the retention label, and (2) on the pink Reissue Notice Card form.

Applicants will normally be given 1 month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of *clear justification* pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Of course, up to 3 months may be set for reply if the examiner determines such a period is clearly justified.

### 1442.02 Concurrent Litigation

In order to avoid duplication of effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended automatically unless and until it is evident to the examiner, or the applicant indicates, that any one of the following applies:

- (A) a stay of the litigation is in effect;
- (B) the litigation has been terminated;
- (C) there are no significant overlapping issues between the application and the litigation; or
- (D) it is applicant's desire that the application be examined at that time.

Where any of (A) - (D) above apply, form paragraphs 14.08-14.10 may be used to deny a suspension of action in the reissue, i.e., to deny a stay of the reissue proceeding.

#### ¶ 14.08 Action in Reissue Not Stayed — Related Litigation Terminated

Since the litigation related to this reissue application is terminated and final, action in this reissue application will **NOT** be stayed. Due to the related litigation status of this reissue application, **EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.**

#### ¶ 14.09 Action in Reissue Not Stayed — Related Litigation Not Overlapping

While there is concurrent litigation related to this reissue application, action in this reissue application will **NOT** be stayed because there are no significant overlapping issues between the application and that litigation. Due to the related litigation status of this reissue application, **EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.**

#### ¶ 14.10 Action in Reissue Not Stayed — Applicant's Request

While there is concurrent litigation related to this reissue application, action in this reissue application will **NOT** be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, **EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.**



# CORRECTION OF PATENTS

1442.04

Where none of (A) through (D) above apply, action in the reissue application in which there is an indication of concurrent litigation will be suspended by the examiner. The examiner should consult with the Group Special Program Examiner prior to suspending action in the reissue. Form paragraph 14.11 may be used to suspend action, i.e., stay action, in a reissue application with concurrent litigation.

## ¶ 14.11 Action in Reissue Stayed — Related Litigation

In view of concurrent litigation, and in order to avoid duplication of effort between the two proceedings, action in this reissue application is **STAYED** until such time as it is evident to the examiner that (1) a stay of the litigation is in effect, (2) the litigation has been terminated, (3) there are no significant overlapping issues between the application and the litigation, or (4) applicant requests that the application be examined.

If the reissue application has been merged with a reexamination proceeding, the merged proceeding generally will not be stayed where there is litigation. In a merged reexamination/reissue proceeding, the reexamination will control because of the *statutory* (35 U.S.C. 305) requirement that reexamination proceedings be conducted with special dispatch. See MPEP § 2285 and § 2286.

## 1442.03 Litigation Stayed

¶ All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to *immediately*. Furthermore, reissue applications involved in "stayed litigation" will be taken up for action in advance of other reissue applications. Great emphasis is placed on the expedited processing of such reissue applications. The courts are especially interested in expedited processing in the Office where litigation is stayed.

In reissue applications with "stayed litigation," the Office will entertain petitions under 37 CFR 1.183, which are accompanied by the fee under 37 CFR 1.17(h), to waive the 2-month delay period under 37 CFR 1.176. Such petitions are decided by the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.

Time-monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each Examining Group. Delays in reissue

processing are to be followed up. The Group Special Program Examiner is responsible for oversight of reissue applications with related litigation.

The purpose of these procedures and those deferring consideration of certain issues, until all other issues are resolved or the application is otherwise ready for consideration by the Board of Patent Appeals and Interferences (note MPEP § 1448), is to reduce the time between filing of the reissue application and final action thereon, while still giving all parties sufficient time to be heard.

Requests for stays or suspension of action in reissues where litigation has been stayed may be answered with Form Paragraph 14.07.

## ¶ 14.07 Action in Reissue Not Stayed — Related Litigation Stayed

While there is concurrent litigation related to this reissue application, action in this reissue application will **NOT** be stayed because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, **EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.**

## 1442.04 Litigation Involving Patent

Where the patent for which reissue is being sought is, or has been, involved in litigation which raised a question material to patentability of the reissue application, such as the validity of the patent, the existence of such litigation must be brought to the attention of the Office by the applicant. This should be done at the time of, or shortly after, filing the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office. The details and documents from the litigation, insofar as they are "material to patentability" of the reissue application as defined in 37 CFR 1.56(b), should accompany the application as filed, or be submitted as promptly thereafter as possible. For example, the defenses raised against validity of the patent would normally be "material to patentability" of the reissue application. It would, in most situations, be appropriate to bring such defenses to the attention of the Office by filing in the reissue application a copy of the Court papers raising such defenses. As a minimum, the applicant should call the attention of the Office to the litigation, the existence and nature of any allegations having a bearing on the validity of the original patent, and the nature of litigation materials relating to these issues. Enough information should be submitted to clearly in-



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8

## RESULT

**OK**

Figure 1 consists of 12 sub-graphs labeled (a) through (l), each plotting a different parameter against time (0 to 24 hours). The parameters and their approximate trends are as follows:

- (a) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (b) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (c) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (d) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (e) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (f) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (g) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (h) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (i) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (j) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (k) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.
- (l) **Rectal temperature (°C)**: Starts at ~37.5°C, rises to ~38.5°C by 12h, then fluctuates between 38.0°C and 38.5°C.